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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,626

11/25/2003

David J. Gervasi

D/A3233Q

7709

25453

7590

06/16/2005

PATENT DOCUMENTATION CENTER

XEROX CORPORATION

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ROCHESTER, NY 14644

EXAMINER

CHEN, SOPHIA S

ART UNIT

PAPER NUMBER

2852

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,626

Applicant(s)

GERVASI ET AL.

Examiner

Sophia S. Chen

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/26/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1, 11 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 2-10 and 12-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 1/26/04 contains three US Patent Application numbers. The Examiner has lined through these numbers because they are not publications. The equivalent patent numbers 6718152, 6747089, and 6767942 are cited in PTO-892 along with this Office action.

Specification

2. The abstract of the disclosure is objected to because of the inclusion of legal phraseology, such as "comprising" (page 34, line 3). Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informality: page 1, paragraph [0001], line 2, the application number and filing date are missing. Appropriate correction is required.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 11, 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al. (US Pat. No. 5,778,290) in view of Carcia et al. (US Pat. No. 6,720,203)

Badesha et al. discloses an apparatus 38 for developing a latent image recorded on a surface 10, comprising: wire supports 54; a donor member 40 spaced from the surface 10 and being adapted to transport toner to a region opposed from the surface 10 (Figure 1); an electrode member 42 positioned in the space between the surface 10 and the donor member 40, the electrode member 42 being closely spaced from the donor member 40 and being electrically biased to detach toner from the donor member 40 thereby enabling the formation of toner cloud in the space between the electrode member 42 and the surface 10 with detached toner from the toner cloud developing the latent image, wherein opposed end regions of the electrode member 42 are attached to wire supports 54 adapted to support the opposed end regions of the electrode member 42 (column 5, lines 24-29; column 8, lines 5-13; Figures 1 and 2); a coating on at least a

portion of nonattached regions of the electrode member 42 (column 8, lines 58-61; column 16, lines 55-57), the coating comprises a polymer such as polyamides, polyimides, and polypropylene (column 9, line 66 to column 10, line 2); the polymer is present in the coating in an amount of from about 0.1 to about 40 percent by weight of total solids (column 16, lines 13-16); the coating has a thickness of from about 1 μm to about 5 μm (column 17, lines 9-11); the coating is present on from about 10 to about 90 percent of the electrode member 42 (column 16, lines 55-57); and the electrode member 42 includes more than one thin diameter wires (column 5, lines 57-60).

Badesha et al. differs from the instant claimed invention in not disclosing the polymer comprising a partly fluorinated polymer.

Carcia et al. discloses polymers including polyamides, polyimides, polypropylene, and partially fluorinated polymer such as polytetrafluoroethylene and copolymers (column 5, lines 11-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the partly fluorinated polymer as taught by Carcia et al. in place of the polymer (such as polyimides) of Badesha et al. to improve resistance to environmental degradation (Carcia et al., column 2, lines 12-20).

Allowable Subject Matter

8. Claims 22 and 23 are allowed.
9. Claims 2-10 and 12-18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Claim 22 is allowable over the prior art of record because the prior art of record does not teach or suggest a coating on at least a portion of nonattached regions of the electrode member, wherein the coating comprises a polymer comprising a partly fluorinated polymer and a fluorinated solvent, in combination with the remaining claimed limitations.

Claim 23 is allowable over the prior art of record because the prior art of record does not teach or suggest a coating on at least a portion of nonattached regions of the electrode member, wherein the coating comprises a polymer comprising a partly fluorinated polymer, a fluorinated solvent, and a superconductor precursor, in combination with the remaining claimed limitations.

Other Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Terry et al. (US Pat. No. 5,453,275) discloses a biocidal protective coating comprising a polymeric composition containing an organic water resistant polymer; and the polymeric material comprises a perfluorinated or partially fluorinated polymer or copolymer.

Badesha et al. (US Pat. No. 5,848,327) discloses a developing device comprising wire supports; a donor member; an electrode member; and a coating on at least a portion of nonattached regions of the electrode member.

Gervasi et al. (US Pat. No. 5,999,781) discloses a developing device comprising wire supports; a donor member; an electrode member; and a coating on at least a portion of nonattached regions of the electrode member.

Gervasi et al. (US Pat. No. 6,456,812 B1) discloses a developing device comprising wire supports; a donor member; an electrode member; and a coating on at least a portion of nonattached regions of the electrode member.

Geervasi et al. (US Pat. No. 6,718,152 B2) discloses a developing device comprising wire supports; a donor member; an electrode member; a coating on at least a portion of nonattached regions of the electrode member; and the coating comprises a fully fluorinated polymer.

Gervasi et al. (US Pat. No. 6,747,089 B2) discloses a fully fluorinated polymer.

Gervasi et al. (US Pat. No. 6,767,942 B2) discloses a fully fluorinated polymer.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sophia S. Chen whose telephone number is (571) 272-2133. The examiner can normally be reached on M-F (7:00-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2852

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sophia S. Chen
Primary Examiner
Art Unit 2852

Ssc
June 14, 2005